

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Shell S. Simpson

Serial No.: 09/928,192

Filed: August 10, 2001

Group Art Unit: 2157

Examiner: Nano, Sargon

Docket No. 10007680-1

For: **Detecting Nearby Devices in a Network Environment**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed September 14, 2007 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to points made in Applicant's Appeal Brief. Applicant addresses those responses in the following.

A. No Teaching or Inherent Requirement of Obtaining an Indication of Which Network Switch Port a Computing Device is Coupled To

On page 13 of the Examiner's Answer, the Examiner again argues that Yacoub teaches obtaining an indication of which port of a network switch to which a computing device is coupled. Applicant notes that, although the Examiner asserted that such an action is taught in Yacoub's paragraph 0020 throughout prosecution of the instant application, the Examiner appears to now abandon that position. Applicant therefore submits that the Examiner now admits that paragraph 0020 does not comprise that teaching. Applicant agrees for the reasons stated in the Appeal Brief.

The Examiner now argues that the claimed "obtaining" action is inherent from the Yacoub reference. In particular, the Examiner argues that it is "assumed" that the network switch "will provide" a port number of a port to which a device is coupled. See *Examiner's Answer*, page 14. In response, Applicant notes that the Examiner's assumption has no basis in the Yacoub disclosure. Instead, the Examiner has used his imagination to conjure up a basis for maintaining a clearly rejection. This is not proper application of 35 U.S.C. § 102, which requires that the unwarranted applied reference actually teach each and every limitation of the rejected claim.

Applicant further notes that inherency must be based on more than mere supposition. Specifically, just because it *may have been possible* for Yacoub's network switch to "provide" a port number does not mean that such an action is inherent in Yacoub's disclosure. As described by the Federal Circuit:

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. See *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Scaltech Inc. v. Retec/Tetra, L.L.C., 178 F.3d 1378, 51 USPQ2d 1055 (Fed. Cir. 1999), Revising, 156 F.3d 1193, 48 USPQ2d 1037 (Fed. Cir. 1998). Furthermore, the Federal Circuit has noted:

Under the principles of inherency, if the prior art *necessarily functions* in accordance with, or includes, the claimed limitations, it anticipates.

Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 51 USPQ2d 1943 (Fed. Cir. 1999) (emphasis added).

In the present case, there is no reason to conclude that a network switch in Yacoub's system necessarily functions to provide port information. Moreover, as noted in the Appeal Brief, Yacoub does not even mention a network switch! Given that fact, it is difficult to understand how the Yacoub reference inherently teaches obtaining an indication of which port of a network switch to which a computing device is coupled.

As a further point, Applicant notes that even if one assumed that Yacoub's system included a network switch and even if one assumed that the network switch stored information as to which devices are connected to which ports, there is still no teaching within the Yacoub reference of an "instruction" that "causes the one or more processors" to perform an act comprising "obtaining . . . an indication of which port of the network switch a computing device is coupled". The absence of such an instruction in Yacoub's system is understandable. Simply stated, no such instruction is needed in Yacoub's system because, unlike the method employed in Applicant's claimed invention, Yacoub's system determines the proximity of a device using a coordinate map, i.e., a map that identifies the locations of devices using x and y coordinates that can be used to calculate distance.

It can therefore be appreciated that Yacoub neither teaches obtaining an indication of which port of a network switch a computing device is coupled, nor inherently requires such an action. It therefore follows that Yacoub cannot be said to anticipate Applicant's claims.

B. No Teaching or Inherent Requirement of Obtaining an Indication of Which Network Switch Port an Identified Device is Coupled To

For the same reasons described above in relation to obtaining an indication of which network switch port a computing device is coupled to, Yacoub does not teach, either explicitly or inherently, "obtaining . . . an indication of which port of the network switch the identified device is coupled to". Again, not only does Yacoub fail to discuss network switches, there is no need for an instruction that causes a processor to obtain

such information given that Yacoub identifies proximate devices using a coordinate map, not information about which network switch ports the devices are coupled to.

C. Determining Physical Distance

On page 14 of the Examiner's Answer, the Examiner alleges that Applicant argued that Yacoub does not teach determining how physically distant an identified device is to a computing device. This is not true. Applicant acknowledges that Yacoub makes a distance determination, albeit using a method completely different from that claimed by Applicant. What Applicant noted in the Appeal Brief is that Yacoub clearly does not teach determining how physically distant an identified device is to a computing device "based at least in part on the indication of which port of the network switch the computing device is coupled to and the indication of which ports of the network switch the one or more identified devices are coupled to".

In view of the above, Applicant submits that the Examiner's statements regarding distance determination on page 14 are not relevant to the instant appeal. Applicant notes, however, that the Examiner is incorrect as to it being "virtually impossible" to determine the physical distance between two devices because "it all depends upon the length of the cable being used to establish the connectivity." *Examiner's Answer*, page 14. This is clearly not so because Yacoub does actually determine distance using a coordinate map. Therefore, the Examiner's comment about it being "virtually impossible" to determine distance due to variation in cable lengths reveals that the Examiner apparently does not understand the teachings of the Yacoub reference and is therefore in no position to apply them against Applicant's claims.

D. Determining Distance Based on Port Connections

On page 15 of the Examiner's Answer, the Examiner appears to criticize Applicant's claimed method of determining the distance of an identified device. In response, Applicant notes whether or not the Examiner now believes that method is particularly desirable has nothing to do with whether Yacoub anticipates the method. It is revealing that the Examiner has not responded to Applicant's points raised in the Appeal Brief as to Yacoub's lack of a teaching of "determining . . . how physically distant the identified device is . . . based at least in part on the indication of which port of the network switch the computing device is coupled to and the indication of which ports of the network switch the one or more identified devices are coupled to". Apparently, the Examiner is attempting to skirt the anticipation issue by attacking Applicant's choice of distance determination. Applicant responds that, irrespective of whether the Examiner favors Applicant's claimed method for determining distance, the fact remains that Yacoub does not teach such a method and therefore cannot be said to anticipate Applicant's claims. Once again, the Yacoub system does not obtain any information as to what devices are connected to which network switch ports. Instead, Yacoub determines location/distance of printers *based upon an X-Y coordinate map and not based upon network configuration*.

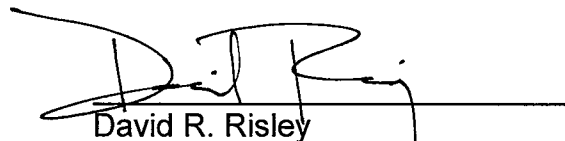
E. Dependent Claims

Applicant finally notes that the Examiner has not responded to the various points raised by Applicant regarding dependent claims 9, 10, 15-18, 23, and 25-28. Applicant takes the Examiner's declination to comment on those points as an admission that Yacoub does not in fact teach the limitations of those claims.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,



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